Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GEOFFREY LOFTUS, GOTTHARD SCHMID, and KLAUS SAUER

Appeal No. 1999-1093
Application No. 08/639,426

ON BRIEF

Before FRANKFORT, NASE and BAHR, Administrative Patent Judges

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's third rejection of claims 1 through 7, which are all of the claims pending in this application.

Appellants' invention is directed to a rotary printing press with units for the direct imaging of the printing forms within the printing units and to a method of influencing and providing ink-trapping behavior to such printing forms that is

improved

over the prior art, particularly during the press start-up phase. As noted on page 2 of the specification, rotary printing presses with units for the direct imaging of the printing forms within the printing units have shown that heating of the printing-form cylinder and the inking unit during direct imaging of the printing forms has extremely undesirable consequences. More specifically, if the temperature of the printing form or the inking unit is to high as a result of thermal conduction or other forms of heat transfer, the printing form and inking unit tend to form scum, and the ink-trapping behavior thereof deteriorates due to the temperature being to high and due to premature vaporization or evaporation of damping medium or ink, thus causing a delay in the direct transition into the production printing run. Appellants' solution to this problem is to provide a printing press (Fig. 1) wherein during the direct imaging process of the printing-form cylinder (8), the inking unit (1) may be disengage from the drive of the printing-form cylinder by

means of a clutch mechanism (15) and, as a result thereof, does not run dry, thereby eliminating the problem of scumming. Thus, the ink balance can be maintained, and the newly imaged printing

form can receive the ink directly from the inking unit when the clutch is re-engaged without having first to produce a large number of waste copies. Independent claims 1 and 2 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellants' brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Mascord	1,301,072	Apr. 15, 1919
Norton et al. (Norton)	3,203,346	Aug. 31, 1965
Harless	3,563,173	Feb. 16, 1971
Krochert et al. (Krochert)	3,744,414	Jul. 10, 1973
Dickerson	4,007,683	Feb. 15, 1977
Fischer	4,290,360	Sep. 22,

Dahlgren et al. (Dahlgren)	4,453,463	Jun. 12, 1984
Hummel et al. (Hummel)	4,567,823	Feb. 04, 1986
Harrison	5,081,928	Jan. 21, 1992
Fadner	5,333,548	Aug. 02, 1994

Claims 2, 4 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Harrison in view of Dickerson and Norton.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fadner in view of Hummel and Harrison.

Claims 2, 3, 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hummel in view of Dahlgren, Harless and Krochert.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hummel in view of Dahlgren, Harless and Krochert as applied to claim 2 above, and further in view of Mascord.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being

unpatentable over Hummel in view of Dahlgren, Harless and Krochert as applied to claim 2 above, and further in view of Fischer.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the examiner's answer (Paper No. 14, mailed October 23, 1998) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed September 14, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions

articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking at independent claim 2 on appeal, we are in complete agreement with appellants (brief, pages 8-10) that when claim 2 is read as a whole and interpreted, as it must be, not in a vacuum, but in light of the specification as it would be understood by one of ordinary skill in the pertinent art (See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997)), the subject matter of claim 2 is limited to a direct imaging rotary printing press having an inking unit "of a direct imaging rotary printing press," a clutch system as claimed and printing unit cylinders including a blanket cylinder, an impression cylinder and "a printing form cylinder to be directly imaged" (i.e., that is capable of being directly imaged).

Since in the examiner's rejection of claims 2, 4 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Harrison in view of

Dickerson and Norton, none of the applied references relates to a direct imaging rotary printing press, it follows that the combination of these references urged by the examiner would not have been suggestive of, or resulted in, the particular form of rotary printing press claimed by appellants. As a further point, we also share appellants' view, noted by the examiner on page 7 of the answer, concerning the "electric clutch" (126) of Harrison and the examiner's conclusion, without any evidence whatsoever, that such a clutch is an "axially acting clutch subjected to a pressure medium," as required in claim 2 on appeal. Since there is no disclosure at all of the structure of the electric clutch (126) in Harrison, we consider it to be rank speculation on the examiner's part to say that it is responsive to the "axially acting clutch subjected to a pressure medium" set forth in appellants' claim 2.

In light of the foregoing, we will not sustain the examiner's rejection of claims 2, 4 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Harrison in view of Dickerson and Norton.

As for the examiner's rejection of claims 2, 3, 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Hummel in view of Dahlgren, Harless and Krochert, we have carefully reviewed the collective teachings of the applied references and find ourselves in agreement with appellants' position set forth on pages 12 and 13 of the brief. Again, since none of the references applied by the examiner relates to a direct imaging rotary printing press as required in claim 2 on appeal, it follows that the combination of these references as urged by the examiner would not have been suggestive of, or resulted in, the particular form of rotary printing press claimed by appellants. Thus, since we have determined that the teachings and suggestions found in Hummel, Dahlgren, Harless and Krochert would not have made the subject matter of claims 2, 3, 5 and 6 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

Regarding the examiner's additional rejections of dependent claims 4 and 7 under 35 U.S.C. § 103(a), we have reviewed the

patents to Fischer and Mascord, but find nothing therein that provides for that which we have indicated above to be lacking in the examiner's basic combination of Hummel, Dahlgren, Harless and Krochert. Accordingly, the examiner's further rejections of claims 4 and 7 under 35 U.S.C. § 103(a) will likewise not be sustained.

The last of the examiner's rejections for our consideration is that of method claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Fadner in view of Hummel and Harrison. Fadner is the only reference relied upon by the examiner that deals with a direct imaging rotary printing press. In the examiner's view (answer, page 8), it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made to broadly utilize a disconnecting clutch within the inking train rollers in Fadner

in such a manner as exemplified by each of Harrison and Hummel. However, even if that were true, we see in the applied references no recognition of appellants' problem or any teaching or suggestion of the particular method set forth in claim 1 on appeal. In that regard, we agree with appellants'

arguments on pages 11 and 12 of their brief and, for those reasons, will not sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Fadner in view of Hummel and Harrison.

In light of the foregoing, we have refused to sustain each and every one of the examiner's rejections before us on appeal. Thus, the decision of the examiner to reject claims 1 through 7 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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LERNER & GREENBERG
POST OFFICE BOX 2480
HOLLYWOOD, FL 33022-2480